

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Christopher D. Roberts et al.
Title: NUCLEOSIDE DERIVATIVES
FOR TREATING HEPATITIS C
VIRUS INFECTION
Appl. No.: 10/676,956
Filing Date: 9/30/2003
Patent No.: 7,425,547
Grant Date: 9/16/2008
Examiner: Lawrence E. Crane
Art Unit: 1623
Confirmation 1045
Number:

CERTIFICATE OF ELECTRONIC TRANSMISSION
I hereby certify that this paper is being electronically
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Deborah Beasley

(Printed Name)

Deborah Beasley
(Signature)

October 28, 2008

(Date of Transmission)

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on September 16, 2008 as U.S. Patent No. 7,425,547.

The Patent Office determined that the patent was entitled to 267 days of PTA. Applicants believe that this PTA determination was made in accordance with the "Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C.

§154(b)(2)(A)” published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office’s interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of “overlap” are limited to “periods of time . . . [that] occur on the same day.” *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays “occur on the same day.” *Id.*

Applicants have recalculated PTA for the captioned patent under the court’s interpretation of the PTA statute, and have determined that the patent is entitled to **782** days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

There were no circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B):	1235 days
(b) Total Applicant delay:	453 days
Final PTA Determination:	782 days

Applicants therefore respectfully request that the patent be accorded **782** days PTA.


The patent is not subject to a terminal disclaimer.

Payment in the amount of \$200 for the requisite fee is submitted herewith via EFS-Web. Should no proper payment be enclosed herewith, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Respectfully submitted,

Date October 28, 2008

By 

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Customer Number: 77977
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Facsimile: (650) 856-3710

Hugo M. Eng, Ph.D.
Registration No. 50,840

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ALL CASES SELECT CASE

Patent Term Adjustment Calculation System

Add a new event to this case

Docket Number: 355491-1250

Application Number: 10/676956

Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	09/30/2003	0		
Edit Delete	Notice to File Missing Parts	12/15/2003	76		
Edit Delete	Response to Notice to File Missing Parts	02/03/2004	126		
Edit Delete	Response to Notice to File Missing Parts	07/06/2004	280		
Edit Delete	IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO	10/04/2004	370		
	14 month From Application date	11/30/2004	427		
Edit Delete	IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO	02/14/2005	503		
Edit Delete	Non-Final Office Action	05/02/2006	945	518	
Edit Delete	Non-Final Office Action	07/24/2006	1,028		
	Non-Final Office Action + 3 months	08/02/2006	1,037		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	08/23/2006	1,058		21
Edit Delete	IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO	09/19/2006	1,085		
	3 Year Period Starts	09/30/2006	1,096		
Edit Delete	IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO	10/24/2006	1,120		
	Non-Final Office Action Rsp. Rcv'd at PTO + 4 mo	12/23/2006	1,180		
Edit Delete	IDS under 1.704(c)(8) filed at PTO	03/28/2007	1,275		217
Edit Delete	Non-Final Office Action	04/11/2007	1,289		
	Non-Final Office Action + 3 months	07/11/2007	1,380		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	10/11/2007	1,472		92
Edit Delete	Notice of Allowance	01/17/2008	1,570		
Edit Delete	Issue Fee Paid	04/11/2008	1,655		
Edit Delete	Rule 312 Amendment Received at PTO	04/11/2008	1,655		
	Issue Fee Paid + 4 months	08/11/2008	1,777		
	Rule 312 Amendment Received at PTO + 4 months	08/11/2008	1,777		123
Edit Delete	Response to Rule 312 Communication Received	08/14/2008	1,780		
Edit Delete	Patent Grant Date	09/16/2008	1,813	717	
			Totals:	1,235	453
			PTA:		782

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Version: 3.01.11

LOGIN: Deborah Jones-Beasley

IP: 10.15.2.78

Foley & Lardner LLP

10/676,956	NUCLEOSIDE DERIVATIVES FOR TREATING HEPATITIS C VIRUS INFECTION	10-27-2008::15:11:08
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Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/676,956

Filing or 371(c) Date:	09-30-2003	USPTO Delay (PTO) Delay (days):	717
Issue Date of Patent:	09-16-2008	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	450
Post-Issue Petitions (days):	+0	Total PTA (days):	267
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
08-27-2008	PTA 36 Months	54	
09-16-2008	Patent Issue Date Used in PTA Calculation	36	
08-15-2008	Dispatch to FDC	↑	
08-14-2008	Application Is Considered Ready for Issue	↑	
08-14-2008	Mail Response to 312 Amendment (PTO-271)	↑	
08-14-2008	Response to Amendment under Rule 312	↑	
06-03-2008	Correspondence Address Change	↑	
04-11-2008	Amendment after Notice of Allowance (Rule 312)		120
04-11-2008	Issue Fee Payment Verified		
04-11-2008	Issue Fee Payment Received		
02-20-2008	Mail Examiner Interview Summary (PTOL - 413)		
02-11-2008	Examiner Interview Summary Record (PTOL - 413)		
01-17-2008	Mail Notice of Allowance		
01-17-2008	Mail Examiner's Amendment		
01-17-2008	Mail Examiner Interview Summary (PTOL - 413)		
01-16-2008	Document Verification		
01-16-2008	Notice of Allowance Data Verification Completed		
01-16-2008	Case Docketed to Examiner in GAU		
01-02-2008	Examiner Interview Summary Record (PTOL - 413)		
01-04-2008	Examiner's Amendment Communication		
10-24-2007	Date Forwarded to Examiner		
10-11-2007	Response after Non-Final Action		92
10-11-2007	Request for Extension of Time - Granted		↑
04-11-2007	Mail Non-Final Rejection	109	
04-04-2007	Non-Final Rejection	↑	
09-19-2006	Information Disclosure Statement considered	↑	
10-24-2006	Information Disclosure Statement considered	↑	
03-28-2007	Information Disclosure Statement considered	↑	
03-28-2007	Reference capture on IDS	↑	
03-28-2007	Information Disclosure Statement (IDS) Filed		217
03-28-2007	Information Disclosure Statement (IDS) Filed		

10-24-2006	Reference capture on IDS	↑
10-24-2006	Information Disclosure Statement (IDS) Filed	↑
10-24-2006	Information Disclosure Statement (IDS) Filed	↑
09-19-2006	Reference capture on IDS	↑
09-19-2006	Information Disclosure Statement (IDS) Filed	↑
09-19-2006	Information Disclosure Statement (IDS) Filed	↑
09-02-2006	Date Forwarded to Examiner	↑
08-23-2006	Response after Non-Final Action	21
08-23-2006	Request for Extension of Time - Granted	↑
07-24-2006	Mail Examiner Interview Summary (PTOL - 413)	↑
07-13-2006	Examiner Interview Summary Record (PTOL - 413)	↑
05-02-2006	Mail Non-Final Rejection	518
05-01-2006	Non-Final Rejection	↑
02-14-2005	Information Disclosure Statement considered	↑
10-04-2004	Information Disclosure Statement considered	↑
11-23-2005	IFW TSS Processing by Tech Center Complete	↑
04-18-2005	Miscellaneous Incoming Letter	↑
03-30-2005	Correspondence Address Change	↑
02-14-2005	Information Disclosure Statement (IDS) Filed	↑
02-14-2005	Information Disclosure Statement (IDS) Filed	↑
11-26-2004	Case Docketed to Examiner in GAU	↑
10-04-2004	Reference capture on IDS	↑
10-04-2004	Information Disclosure Statement (IDS) Filed	↑
10-04-2004	Information Disclosure Statement (IDS) Filed	↑
07-06-2004	CRF Is Good Technically / Entered into Database	↑
05-04-2004	Correspondence Address Change	↑
04-20-2004	Application Return from OIPE	↑
04-20-2004	Application Return TO OIPE	↑
04-20-2004	Application Dispatched from OIPE	↑
04-20-2004	Application Is Now Complete	↑
02-03-2004	Additional Application Filing Fees	↑
02-03-2004	CRF Disk Has Been Received by Preexam / Group / PCT	↑
02-17-2004	CRF Is Good Technically / Entered into Database	↑
12-15-2003	SEQUENCE ERRORS	↑
09-30-2003	CRF Disk Has Been Received by Preexam / Group / PCT	↑
12-11-2003	Cleared by OIPE CSR	↑
11-11-2003	IFW Scan & PACR Auto Security Review	↑
10-20-2003	CRF Is Flawed Technically / Not Entered into Database	↑
09-30-2003	CRF Disk Has Been Received by Preexam / Group / PCT	↑
09-30-2003	Initial Exam Team nn	↑

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